REMARKS

In the Office Action mailed March 20, 2008 (hereinafter "Office Action"), Claims 2, 5, 8, 11, 14, 17, 24, 27, 30, and 34 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-27 and 38-42 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Publication No. 2004/0057348, by Shteyn et al. (hereinafter "Shteyn"), in view of U.S. Publication No. 2003/0131715, by Georges (hereinafter "Georges").

With this response, Claims 1-14, 16, 17, 23, 24, 26, 27, 38, and 42 have been amended. Claims 1-14, 16, 17, 19-24, 26, 27, and 38-42 are pending in this application. Applicants have carefully considered the issues raised in the Office Action and, in view of the amendments and remarks set forth below, request reconsideration and allowance of the claims.

Interview Summary

Applicants thank Examiner Augustin for his time during a telephone interview conducted on April 8, 2008, with applicants' representatives. While distinctions between the claimed features and the cited publications were discussed, no agreement was reached with regard to patentability.

35 U.S.C. § 112, Second Paragraph, Rejections

The Office Action rejected Claims 2, 5, 8, 11, 14, 17, 24, 27, 30, and 34 under 35 U.S.C. § 112, second paragraph, as indefinite for use of the word "may". In response, applicants have amended Claims 2, 5, 8, 11, 14, 17, 24, and 27 to replace the phrase "may be obtained" with the phrase "is obtainable." Claims 30 and 34 have been canceled. Accordingly, applicants respectfully submit that the 35 U.S.C. § 112, second paragraph, rejections are rendered moot, and respectfully request withdrawal of the rejections.

<u>35 U.S.C. § 103(a) Rejections</u>

<u>Claim 1</u>

The Office Action rejected independent Claim 1 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. Applicants respectfully disagree, but have nevertheless amended the claim in order to further advance prosecution of the present application.

As amended, Claim 1 recites:

> 1. A method for playing audio tracks on a computing device according to a globally relevant playlist, the method comprising:
>
> selecting a first track referenced by the globally relevant playlist, the first track being associated with a first global track identifier, *the first global track identifier being generated as a function of the contents of the first track to uniquely identify the contents of the first track*;
>
> determining whether the first track is locally accessible to the computing device according to the first global track identifier by comparing the first global track identifier to each of a plurality of local global track identifiers; and
>
> if, according to the previous determination, the first track is locally accessible to the computing device, playing the first track on the computing device. (Emphasis added.)

Applicants respectfully submit that Shteyn and Georges fail to teach or suggest, either alone or in combination, the combination of features recited in Claim 1, including a global track identifier that is "generated as *a function of the contents of the first track* to *uniquely identify the contents of the first track*," as recited in amended Claim 1.

The Office Action alleges that Shteyn discloses an "identification of the content." Office Action, para. 7A (citing Shteyn, paras. 6, 9, 23, 27). The Office Action then alleges that this "identification of the content" discloses the first global track identifier recited in Claim 1, before amendment. Applicants respectfully disagree, and submit that Shteyn fails to disclose or suggest

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a "first global track identifier being generated as a function of the contents of the first track to uniquely identify the contents of the first track," as recited in amended Claim 1.

Paragraphs 9, 23, and 27 of Shteyn merely disclose an "identification of each content item in the playlist." Paragraph 6 discloses that the playlist "generally contains an identification of the song and the artist, and an identification of the file that includes the song." None of these passages disclose or suggest a global track identifier that *uniquely identifies* a track. An identification of a song, an artist, or a file would not necessarily be unique — a given artist will likely have many songs; a given song may be recorded by many artists (or recorded many different times by the same artist); and a file may have its contents duplicated or altered, its location changed, or its filename duplicated or altered.

Further, none of these passages disclose or suggest a global track identifier that is *generated as a function of the contents of a track*. While Shteyn may disclose an identification of a "content item" that refers to the song, the artist, or the file, Shteyn nevertheless does not teach or suggest that the identification is generated as a *function* of the *contents* of the track. One skilled in the art would recognize that any differences in the content of a track would lead to the creation of a different global track identifier, if the global track identifier is generated as a function of the contents of the track as recited in amended Claim 1. In contrast, even if the contents of a "content item" in Shteyn are different, it could still be referred to by the same song, artist, or file designations.

Applicants therefore respectfully submit that nothing in Shteyn discloses or suggests a "first global track identifier being generated as a function of the contents of the first track to uniquely identify the contents of the first track," as recited in amended Claim 1. Furthermore, applicants respectfully submit that nothing in Georges or any of the other patents and publications of record make up for these deficiencies in Shteyn.

As set forth by the Supreme Court, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007). Moreover, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit.

The Office Action has apparently relied upon one of the rationales suggested in *KSR* for rejecting Claim 1, particularly "combining prior art elements according to known methods to yield predictable results." However, as recited in the M.P.E.P. § 2143(A), **"if any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art."** (Emphasis added.)

The Office Action suggests that Shteyn and Georges disclose each of the elements of Claim 1. However, as illustrated above, Shteyn and Georges fail to disclose each element of Claim 1. Accordingly, the rationale set forth by the Office Action cannot support a conclusion that Claim 1 would be obvious to one of ordinary skill in the art. Applicants, therefore, request that the 35 U.S.C. § 103(a) rejection of Claim 1 be withdrawn and the claim allowed.

Claims 2-6

Claims 2-6 depend from Claim 1. Applicants respectfully submit that these claims are allowable at least by virtue of these dependencies, as well as by virtue of the additional claim features set forth therein.

Accordingly, applicants respectfully submit that Claims 2-6 are allowable, and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

Claim 7

The Office Action rejected independent Claim 7 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. Applicants respectfully disagree, but have

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nevertheless amended the claim in order to further advance prosecution of the present application.

As amended, Claim 7 recites:

> 7.   A tangible computer-readable storage medium having computer-executable instructions which, when executed, carry out a method for playing audio tracks on a computing device, the method comprising:
>
> selecting a first track referenced by a globally relevant playlist, the first track being associated with a first global track identifier, *the first global track identifier being generated as a function of the contents of the first track to uniquely identify the contents of the first track*;
>
> determining whether the first track is locally accessible to the computing device according to the first global track identifier by comparing the first global track identifier to each of a plurality of local global track identifiers; and
>
> if, according to the previous determination, the first track is locally accessible to the computing device, playing the first track on the computing device. (Emphasis added.)

As discussed above with respect to Claim 1, applicants respectfully submit that Shteyn and Georges fail to teach or suggest, either alone or in combination, the combination of features recited in Claim 7, including a global track identifier that is "generated as *a function of the contents of the first track* to *uniquely identify the contents of the first track*," as recited in amended Claim 7.

Accordingly, for at least the reasons discussed above with respect to Claim 1 (as well as other reasons), applicants respectfully submit that Claim 7 is patentable, and request that the 35 U.S.C. § 103(a) rejection be withdrawn and the claim allowed.

Claims 8-12

Claims 8-12 depend from Claim 7. Applicants respectfully submit that these claims are allowable at least by virtue of these dependencies, as well as by virtue of the additional claim features set forth therein.

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Accordingly, applicants respectfully submit that Claims 8-12 are allowable, and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

Claim 13

The Office Action rejected independent Claim 13 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. Applicants respectfully disagree, but have nevertheless amended the claim in order to further advance prosecution of the present application.

As amended, Claim 13 recites:

13. A method for downloading tracks from a computing device onto a player device according to a globally relevant playlist, the method comprising:

selecting a first track encoded in a first format referenced by the globally relevant playlist, the first track encoded in the first format being associated with a first global track identifier, *the first global track identifier being generated as a function of the contents of the first track encoded in the first format to uniquely identify the contents of the first track encoded in the first format*;

determining whether the first track encoded in the first format is locally accessible to the computing device according to the first global track identifier by comparing the first global track identifier to each of a plurality of local global track identifiers; and

if, according to the previous determination, the first track encoded in the first format is locally accessible to the computing device, downloading the first track encoded in the first format from the computing device to the player device; and

if, according to the previous determination, the first track encoded in the first format is not locally accessible to the computing device:
determining a second global track identifier identifying the first track encoded in a second format, *the second global track identifier being generated as a function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format*;
determining whether the first track encoded in the second format is locally accessible to the computing device according to the

second global track identifier by comparing the second global track identifier to each of a plurality of local global track identifiers; and

if, according to the previous determination, the first track encoded in the second format is locally accessible to the computing device, downloading the first track encoded in the second format from the computing device to the player device. (Emphasis added.)

Applicants respectfully that Shteyn and Georges fail to disclose or suggest, either alone or in combination, the combination of features in amended Claim 13, including selecting a "first global track identifier being *generated as a function of the contents of [a] first track encoded in [a] first format* to *uniquely identify the contents of the first track encoded in the first format*," "determining whether the first track encoded in the first format is locally accessible to the computing device according to the first global track identifier *by comparing the first global track identifier to each of a plurality of local global track identifiers*," and, if not locally accessible, "*determining a second global track identifier* identifying the first track encoded in a second format, *the second global track identifier being generated as a function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format*," as recited in amended Claim 13.

For at least the reasons discussed above with regard to Claims 1 and 7, applicants respectfully submit that Shteyn and Georges fail to disclose or suggest, both alone and in combination, a "first global track identifier being generated as *a function of the contents of [a] first track encoded in [a] first format* to *uniquely identify the contents* of the first track encoded in the first format," or a "second global track identifier being generated as *a function of the contents of the first track encoded in [a] second format to uniquely identify the contents of the first track in the second format*," as recited in amended Claim 13.

Further, applicants respectfully submit that Shteyn and Georges fail to disclose or suggest, both alone and in combination, "determining a second global track identifier identifying the first track encoded in a second format; *the second global track identifier being generated as a*

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function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format," as recited in amended Claim 13. The Office Action admits that Shteyn does not explicitly disclose a specification of a track format. *See* Office Action, para. 8. The Office Action then cites paragraph 103 of Georges, which merely discloses recording samples in different formats, as disclosing these features.

Applicants respectfully submit that the mere description of recording in different formats from Georges is insufficient to make up for the deficiencies of Shteyn. Even if Georges describes the use of multiple formats, Georges merely discloses *recording* in a variety of formats. Georges does not disclose or suggest finding a first track encoded in a second format by "determining a second global track identifier identifying the first track encoded in a second format," as recited in amended Claim 13.

Accordingly, applicants respectfully submit that Claim 13 is patentable, and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

Dependent Claims 14, 16, and 17

Claims 14, 16, and 17 depend from Claim 13. Applicants respectfully submit that these claims are allowable at least by virtue of these dependencies, as well as by virtue of the additional claim features set forth therein.

Accordingly, applicants respectfully submit that Claims 2-6, 8-12, 14, 16, 17, 24, 26, 27, and 42 are allowable, and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

Dependent Claims 19-22

The Office Action rejected dependent Claims 19-22 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. As the Office Action failed to meet the burden to

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establish a *prima facie* conclusion of obviousness with respect to these claims, applicants respectfully traverse these rejections.

Specifically, the Office Action cited no evidence or reasoning showing the obviousness of "determining whether . . . the first format is compatible with the player device," as recited in Claims 19 and 21; "on the computing device, converting the first track encoded in the first format to a format compatible with the player device," as recited in Claim 20; or "on the computing device, converting the selected additional track encoded in the first format to a format compatible with the player device," as recited in Claim 22.

An Office Action must meet the initial burden of factually supporting any *prima facie* conclusion of obviousness. The analysis supporting a rejection under § 103 should be made explicit; rejections on obviousness cannot be sustained with mere conclusory statements. Instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See* M.P.E.P. §§ 2142, 2143; *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 U.S.P.Q.2d 1385, 1396 (2007); *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006). Accordingly, applicants respectfully submit that the Office Action failed to meet the burden for establishing a *prima facie* case of obviousness, and therefore submit that the 35 U.S.C. § 103(a) rejections were made in error.

Further, Claims 19-22 depend from Claim 13. Applicants respectfully submit that these claims are also allowable at least by virtue of these dependencies, as well as by virtue of the additional claim features set forth therein.

For at least these reasons, applicants respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

Claim 23

The Office Action rejected independent Claim 23 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. Applicants respectfully disagree, but have

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nevertheless amended the claim in order to further advance prosecution of the present application.

As amended, Claim 23 recites:

> 23. A tangible computer-readable storage medium having computer-executable instructions which, when executed, carry out a method for downloading tracks from a computing device onto a player device, the method comprising:
>
> selecting a first track encoded in a first format referenced by a globally relevant playlist, the first track encoded in the first format being associated with a first global track identifier, *the first global track identifier being generated as a function of the contents of the first track encoded in the first format to uniquely identify the contents of the first track encoded in the first format*;
>
> determining whether the first track encoded in the first format is locally accessible to the computing device according to the first global track identifier by comparing the first global track identifier to each of a plurality of local global track identifiers; and
>
> if, according to the previous determination, the first track encoded in the first format is locally accessible to the computing device, downloading the first track from the computing device to the player device; and
>
> if, according to the previous determination, the first track encoded in the first format is not locally accessible to the computing device:
>
> determining a second global track identifier identifying the first track encoded in a second format, *the second global track identifier being generated as a function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format*;
>
> determining whether the first track encoded in the second format is locally accessible to the computing device according to the second global track identifier by comparing the second global track identifier to each of a plurality of local global track identifiers; and
>
> if, according to the previous determination, the first track encoded in the second format is locally accessible to the computing device, downloading the first track encoded in the second format from the computing device to the player device. (Emphasis added.)

As discussed above with respect to Claim 13, applicants respectfully submit that Shteyn and Georges fail to teach or suggest, either alone or in combination, the combination of features recited in Claim 23, including selecting a "first global track identifier being *generated as a function of the contents of [a] first track encoded in [a] first format* to *uniquely identify the contents of the first track encoded in the first format*," "determining whether the first track encoded in the first format is locally accessible to the computing device according to the first global track identifier *by comparing the first global track identifier to each of a plurality of local global track identifiers*," and, if not locally accessible, "*determining a second global track identifier* identifying the first track encoded in a second format, *the second global track identifier being generated as a function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format*," as recited in amended Claim 23.

Accordingly, for at least the reasons discussed above with respect to Claim 13 (as well as other reasons), applicants respectfully submit that Claim 23 is patentable, and request that the 35 U.S.C. § 103(a) rejection be withdrawn and the claim allowed.

Dependent Claims 24, 26, and 27

Claims 24, 26, and 27 depend from Claim 23. Applicants respectfully submit that these claims are allowable at least by virtue of these dependencies, as well as by virtue of the additional claim features set forth therein.

Accordingly, applicants respectfully submit that Claims 2-6, 8-12, 14, 16, 17, 24, 26, 27, and 42 are allowable, and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

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<u>Claim 38</u>

The Office Action rejected independent Claim 38 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. Applicants respectfully disagree, but have nevertheless amended the claim in order to further advance prosecution of the present application.

As amended, Claim 38 recites:

38. A method for playing audio tracks according to a globally relevant playlist, the method comprising:

selecting a first global track identifier from a globally relevant playlist, the first global track identifier identifying a first track encoded in a first format, *the first global track identifier being generated as a function of the contents of the first track encoded in the first format to uniquely identify the contents of the first track encoded in the first format*;

determining whether the first track encoded in the first format is locally accessible to the computing device according to the first global track identifier by comparing the first global track identifier to each of a plurality of local global track identifiers; and

if, according to the previous determination, the first track encoded in the first format is locally accessible to the computing device, playing the first track encoded in the first format on the computing device;

if, according to the previous determination, the first track encoded in the first format is not locally accessible to the computing device:

determining a second global track identifier identifying the first track encoded in a second format, *the second global track identifier being generated as a function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format*;

determining whether the first track encoded in the second format is locally accessible to the computing device according to the second global track identifier by comparing the second global track identifier to each of a plurality of local global track identifiers; and

if, according to the previous determination, the first track encoded in the second format is locally accessible to the computing device, playing the first track encoded in the second format on the computing device. (Emphasis added.)

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As discussed above with respect to Claims 13 and 23, applicants respectfully submit that Shteyn and Georges fail to teach or suggest, either alone or in combination, the combination of features recited in Claim 38, including selecting a "first global track identifier being *generated as a function of the contents of [a] first track encoded in [a] first format* to *uniquely identify the contents of the first track encoded in the first format*," "determining whether the first track encoded in the first format is locally accessible to the computing device according to the first global track identifier *by comparing the first global track identifier to each of a plurality of local global track identifiers*," and, if not locally accessible, "*determining a second global track identifier* identifying the first track encoded in a second format, *the second global track identifier being generated as a function of the contents of the first track encoded in the second format to uniquely identify the contents of the first track in the second format*," as recited in amended Claim 38.

Accordingly, for at least the reasons discussed above with respect to Claims 13 and 23 (as well as other reasons), applicants respectfully submit that Claim 38 is patentable, and request that the 35 U.S.C. § 103(a) rejection be withdrawn and the claim allowed.

Dependent Claims 39-41

The Office Action rejected dependent Claims 39-41 under 35 U.S.C. § 103(a) as unpatentable over Shteyn in view of Georges. As the Office Action failed to meet the burden to establish a *prima facie* conclusion of obviousness with respect to these claims, applicants respectfully traverse these rejections.

As outlined above with respect to Claims 19-22, the Office Action must meet the initial burden of factually supporting a *prima facie* conclusion of obviousness. *See, e.g.*, M.P.E.P. §§ 2142, 2143. Applicants respectfully submit that the Office Action failed to meet this burden for rejecting Claims 39-41 under 35 U.S.C. § 103.

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Claims 39-41 recite:

> 39.   The method of Claim 38, wherein the first global track identifier is associated with a set of alternative global track identifiers, and wherein determining a second global track identifier identifying the first track encoded in a second format comprises determining the second global track identifier from the set of alternative global track identifiers.
>
> 40.   The method of Claim 39, wherein the set of alternative global track identifiers is found in a database of global track identifiers.
>
> 41.   The method of Claim 39, wherein the set of alternative global track identifiers is found in the globally relevant playlist.

The Office Action stated no evidence or reasoning showing the obviousness of a method "wherein the first global track identifier is associated with a set of alternative global track identifiers," as recited in Claim 39. The Office Action similarly did not state any evidence or reasoning showing the obviousness of any of the other features recited in Claims 39-41. Accordingly, applicants respectfully submit that the Office Action failed to meet the burden for establishing a *prima facie* case of obviousness, and therefore the 35 U.S.C. § 103(a) rejections were made in error.

Further, Claims 39-41 depend from Claim 38. Applicants respectfully submit that these claims are also allowable at least by virtue of these dependencies, as well as by virtue of the additional claim features set forth therein.

For at least these reasons, applicants respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

Dependent Claim 42

Claim 42 depends from Claim 38. Applicants respectfully submit that this claim is allowable at least by virtue of this dependency, as well as by virtue of the additional claim features set forth therein.
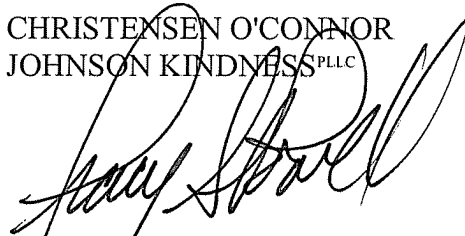
Accordingly, applicants respectfully submit that Claim 42 is allowable, and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims allowed.

CONCLUSION

In view of the foregoing amendments and remarks, applicants submit that Claims 1-14, 16, 17, 19-24, 26, 27, and 38-42 are in condition for allowance over the cited and applied references, and respectfully request reconsideration and allowance of the same. The Examiner is invited to contact applicants' attorney at the number provided below to resolve any issues that may arise in order to advance prosecution of this application.

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